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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.              | CONFIRMATION NO.       |
|--|-------------|----------------------|----------------------------------|------------------------|
| 10/642,776   | 08/18/2003  | Swapan Roy           | 406-01                           | 3684                   |
| 39065 7590 12/31/2007<br>PROTEUS PATENT PRACTICE LLC<br>P.O. BOX 1867<br>NEW HAVEN, CT 06508 |             |                      | EXAMINER<br>GROSS, CHRISTOPHER M |                        |
|  |             |                      | ART UNIT<br>1639                 | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>12/31/2007          | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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|-----------------------------|--------------------------|------------------------------------|-------------------------------|
| APPLICATION NO.<br>10642776 | FILING DATE<br>8/18/2003 | FIRST NAMED INVENTOR<br>ROY ET AL. | ATTORNEY DOCKET NO.<br>406-01 |
|-----------------------------|--------------------------|------------------------------------|-------------------------------|

PROTEUS PATENT PRACTICE LLC  
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|----------|
| EXAMINER |
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Christopher M. Gross

|          |       |
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| ART UNIT | PAPER |
|----------|-------|

1639

20071218B

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

see attached

**Notice of Non-Compliant  
Amendment (37 CFR 1.121)**

Application No.

10/642,776

Examiner

Christopher M. Gross

Applicant(s)

ROY ET AL.

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 13 October 2007 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
  - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
  - ☐ C. Other \_\_\_\_\_.
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
  - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☒ E. Other: See Continuation Sheet.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):  
\_\_\_\_\_

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

**TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:**

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

**Extensions of time** are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

**Failure to timely respond** to this notice will result in:

**Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

**Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable

Telephone No.

Continuation of 4(e) Other: Amended claims must commence on a separate physical sheet and may not include any other parts of the application or other materials see 37 CFR 1.75 (2)(h).

### COMMUNICATION

The communication filed on 10/13/2007 is not fully responsive to the prior Office Action because (i) the amendments to the claims are not in compliance with 37 CFR 1.121 and (ii) an election of a spacer has not been made.

(i) The claim listing submitted 10/13/2007 includes arguments; however it is noted claims must commence on a separate physical sheet and not include other parts of the application according to 37 CFR 1.75(2)(h) and 37 CFR 1.52(3).

(ii) It is acknowledged that applicant has elected: "silica surface" for the species of support, reading on claims 1,5,6,7,10,14,15 and 16 according to applicant and "succinyl group" for the species of specificity determining ligand, reading on claim 1,2,10 and 11 according to applicant.

Applicant states, see p 13 paragraph 4 Remarks filed 10/13/2007, that claim 1 and 4 have been amended to delete the genus of spacer. On the contrary, claim 4 now explicitly *requires* a spacer, which was previously set forth as "optional." Therefore, in accordance with the restriction mailed 10/11/2006, applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable .

(From claim 4) **spacer**: Applicant is required to elect a *single* particular structure, specified as to atom and bond from which the search will commence. For example, applicant might elect the top spacer found in paragraph 0059 of the present published application where m is 2 . Applicant is strongly encouraged to elect using a structural representation. Currently, claims 1 and 4 are generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Like the aforementioned elections, **applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species, including any claims subsequently added**. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Since the above-mentioned reply appears to be bona fide, applicant is given ONE(1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Gross whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Douglas Schultz can be reached on 571 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number:  
10/642,776  
Art Unit: 1639

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Christopher M Gross  
Examiner  
Art Unit 1639

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MARK L. SHIBUYA  
PRIMARY EXAMINER